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Laurence & Phillips IP Law LLP  
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EXAMINER
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FADOK, MARK A

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* DAVID H. TANNENBAUM

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Appeal 2016-004356  
Application 13/272,853  
Technology Center 3600

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Before NINA L. MEDLOCK, AMEE A. SHAH, and  
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

FINAMORE, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Pursuant to 37 C.F.R. § 41.52, Appellant filed a Request for Rehearing on December 26, 2017 (“Req. Reh’g”), seeking reconsideration of our Decision on Appeal mailed October 25, 2017 (“Dec.”). We have jurisdiction over the Request under 35 U.S.C. § 6(b).

ANALYSIS

A request for rehearing “must state with particularity the points believed to have been misapprehended or overlooked by the Board.” 37 C.F.R. § 41.52(a). Arguments not raised and evidence not previously

relied upon in the briefs on appeal are not permitted, except in the limited circumstances set forth in §§ 41.52(a)(2)–(4).

Appellant contends that the Board misconstrued Appellant’s arguments regarding the claim limitation “determining a current location of said device” in affirming the Examiner’s decision to reject claims 19–22 and 29–40 under 35 U.S.C. § 101 as non-statutory subject matter. Req. Reh’g 2. More specifically, Appellant asserts that the claimed device does not perform generic data processing, but instead is the object of the processing, i.e., the location being determined. *Id.* As such, Appellant argues that, unlike the claims in *Affinity Labs of Texas, LLC v. Amazon.com, Inc.*, 838 F.3d 1266 (Fed. Cir. 2016) and *In re TLI Communications LLC Patent Litigation*, 823 F.3d 607 (Fed. Cir. 2016), removal of the device would affect the nature of the processing, not the entity performing the processing. *Id.* at 2–4. Appellant also asserts that the Board’s treatment of the claimed device as a generic computer is improper because removing the device from consideration changes the character of the abstract idea, i.e., “providing advertisements based on a location of the device.” *Id.* at 4–5. Appellant’s arguments are not convincing.

At the outset, we disagree with Appellant’s assertion that removing the device from consideration changes the character of the abstract idea. Here, the claimed device is a generic computer component, as set forth in the Decision on Appeal and unrefuted by Appellant. Dec. 5. Given that the claimed device is a generic computer component, the inclusion or omission of the device in the abstract idea does not affect the character of the abstract idea. Whether we characterize the claims as “providing advertisements based on a location of the device” or simply “providing advertisements

based on a location” these characterizations, albeit at different levels of abstraction, describe the character of each claim as a whole. *See Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016) (“An abstract idea can generally be described at different levels of abstraction.”). As such, Appellant’s argument regarding the inclusion of the device in the abstract idea does not apprise us of error in the Examiner’s determination that the claims are directed to an abstract idea under the first step of the patent-eligibility analysis.

Turning to the second step of the analysis, the Supreme Court, in *Alice*, explains that the second step of the patent-eligibility analysis considers “the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice Corp. Pty Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1297–98 (2012)). The Court further explained that the recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. *Id.* at 2358. Notably, in describing the second step of the patent-eligibility analysis, the Court did not draw a distinction between a generic computer performing the processing and a generic computer being the object of the processing. The Court simply held that the generic computer implementation of an abstract idea is insufficient to transform the abstract idea into a patent-eligible application under the second step. *Id.* at 2357 (“[C]laims, which merely require generic computer implementation, fail to transform [the] abstract idea into a patent-eligible invention.”).

As set forth above, the claimed device is a generic computing component. Dec. 5. Furthermore, as we explain in the Decision on Appeal, the claims do not describe how the location of the device is determined, and we fail to see how determining the location of the device requires something other than generic computer functions, such as receiving, processing, and transmitting data. *Id.* As such, removal of the device would not change the nature of the processing, i.e., how the location is determined. Regardless of whether the computer implementation of the claimed invention results in the device performing the processing or being the object of the processing, the claimed invention is nonetheless the generic computer implementation of the abstract idea, which is not a patent-eligible application of the abstract idea.

In view of the foregoing, Appellant's arguments do not affect our determination that the Examiner did not err in determining that the claims are patent-ineligible, i.e., judicially-excepted from statutory subject matter. We, therefore, decline to modify our decision affirming the Examiner's decision to reject claims 19–22 and 29–40 under 35 U.S.C. § 101.

#### DECISION

We have reconsidered our Decision on Appeal in light of Appellant's Request for Rehearing, and we deny Appellant's request to modify our original Decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). 37 C.F.R. § 1.136(a)(1)(iv).

DENIED